

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 8-39 will be pending, claims 8, 13, and 21 being independent.

Summary of Office Action

Claims 8-13 are rejected under 35 USC §102(b) as being anticipated by BEJEAN et al. (U.S. Patent No. 5,011,179, hereafter "BEJEAN").

Claims 14, 15, and 17-26 are rejected under 35 USC §103(a) as being unpatentable over BEJEAN in view of GIGNOUX et al. (U.S. Patent No. 6,390,494, hereafter "GIGNOUX").

Claim 16 is rejected under 35 USC §103(a) as being unpatentable over BEJEAN in view of KENNEY (U.S. Patent No. 6,257,620).

Response to the Office Action

A. Summary of the Amendment

Amendments of a cosmetic nature have been made to paragraph 0003 of the specification.

Independent claim 8, directed to a "cross-country ski system," has been amended to specify that the central zone of the cross-country ski of the invention is "constructed and arranged to receive a device structured and arranged to engage a part of the boot in an area corresponding to a metatarsophalangeal bending zone of a wearer's foot for binding the boot to the ski."

Independent claim 13 has been amended to specify that the binding device is "constructed and arranged to be fixed on the ski in the upwardly facing recess of the location for receiving the binding device"

New claims 27-39 have been added.

B. Withdrawal of the Rejection Based Upon BEJEAN

Applicants kindly request reconsideration and withdrawal of the rejection of claims 8-13 as being anticipated by BEJEAN at least for the following reasons.

In rejecting claims under 35 USC §102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

The rejection is predicated, among other things, upon BEJEAN’s recess 5c corresponding to Applicants’ recitation of “an upwardly facing recess of the upper surface of the ski” as a “location for receiving the binding device.” See page 3, lines 2-3, of the Office action.

BEJEAN’s recess 5c, on the other hand, is a longitudinal groove in the upper surface 5d of the lower portion 5a of the longitudinal guide rib 5 (in the embodiment of Fig. 4 – see column 3, lines 29-46) which cooperates, during cross-country skiing, with the sole 3 of a ski boot whose sole 3 contains on its lower surface longitudinal groove 4 ...” (see column 2, lines 63-65).

BEJEAN’s longitudinal groove/recess 5c receives *not a binding device* but an “elastomeric bar” 5b, i.e., the upper portion of the guide rib 5 (see column 3, lines 35-38).

In fact, the binding is not illustrated in BEJEAN’s drawing. Instead, BEJEAN makes clear, as explained in the background and in the summary of the invention that the invention is that of a “lateral guide apparatus.” See, e.g., the title of BEJEAN’s invention and column 1, lines 57-61: “... resilient means ... interposed between the bottom of the groove in said shoe and the top of the ski for resilient compression in response to the seating of the sole on the top of the ski.”

BEJEAN’s invention is described as being adapted for a ski shoe “whose toe is attached to the ski” See, e.g., column 1, lines 48-49. This is the type of binding Applicants’ invention is an improvement upon or, stated differently, Applicants’ invention is an improvement for a type of binding which is described by Applicants in their paragraphs 0004-0006, which is a successor to the type of binding disclosed by BEJEAN, i.e., one in which the boot is articulated about an axis rearward of the front end of the sole (see Applicants’ paragraph 0004). In fact, as Applicants explain in their paragraph 0007, it is a particular characteristic of the successor types of binding which raises the boot from the upper surface of the ski.

Other examples of bindings of the aforementioned type, by which the boot is attached to the ski forward of the sole, are those shown in commonly owned U.S. Patent Nos. 4,789,177 and 4,842,293. In US '177 the binding-engaging loop is shown in Figs. 1, 3, and 7 to extend forwardly of the boot and sole and, in US '293, the binding 5 is shown also to be forward of the boot and sole.

Because recess 5c of BEJEAN is not an upwardly facing recess for receiving a binding device, BEJEAN fails to anticipate Applicants' invention as recited in independent claim 1.

Likewise, because BEJEAN fails to disclose a binding device in recess 5c, BEJEAN fails to anticipate Applicants' invention as recited in independent claim 1.

C. Withdrawal of the Rejection Based Upon BEJEAN+GIGNOUX

Applicants kindly request reconsideration and withdrawal of the rejection of claims 14, 14, and 17-26 as being unpatentable over BEJEAN in view of GIGNOUX at least for the following reasons.

While the analysis of a claim, in the context of 35 USC §103, allows flexibility in determining whether a claimed invention would have been obvious, as expressed in *KSR Int'l Col. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it still requires that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* "We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention." *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

Applicants respectfully submit that one skilled in the art would not have modified the ski and binding of BEJEAN by removing BEJEAN's binding in favor of that of GIGNOUX.

The reason given in the Office action to support the conclusion of obviousness is that such modification would have been made "to provide a short, compact binding that does not interfere with the boot movement." See page 4, lines 3 and 4 of the Office action.

But BEJEAN already provides a short, compact binding that does not interfere with the boot movement. Accordingly, one skilled in the art, for that reason, would not have sought a binding that is different from that of BEJEAN. Applicants respectfully submit that the rationale advanced in support of such modification is evidence, then, of the aforementioned warning in *KSR* against hindsight reconstruction of references to reach the claimed invention.

In further support of the rejection based upon the combination of BEJEAN and GIGNOUX, page 4 of the Office action states that “[t]here is no baseplate mounted between the boot and the upper support surface of the ski in either the system shown by Bejean et al. (see Fig. 4) or the system shown by Gignoux et al. (see Fig. 1) that would interfere with contact between the boot and the lateral upper support surfaces.”

Of course, Applicants stipulate that BEJEAN provides for contact between the sole of the boot and the upper surface of the ski. This is consistent with Applicants’ background presented in their paragraphs 0002-0007 of their specification. The binding to be used with the lateral guide apparatus of BEJEAN is the type mentioned in Applicants’ paragraph 0002, viz., one in which the binding locked the front end of the ski boot so that the rear could be alternately raised and lowered relative to the upper surface of the ski. Other examples of such bindings, shown in greater detail than in the drawings of BEJEAN, are those of the aforementioned commonly owned U.S. Patent Nos. 4,789,177 and 4,842,293.

GIGNOUX says nothing about contact between the ski 9 and the boot 60. The drawings show no specific engagement. Moreover, if the schematic depiction of the boot 60 shown in GIGNOUX’s Fig. 6, i.e., by means of a photocopy of such boot, is overlaid upon Fig. 6, with the lowermost edge of the boot 60 horizontal, and pivot points 61 of the boots of Fig. 6 and the photocopy aligned, a space appears between lowermost edge of the boot and the upper surface of the ski. Still further, rearward of the “rear bar 62” in GIGNOUX’s Fig. 1, Fig. 4, and Fig. 6 shows two closely positioned parallel lines atop what appears to be the upper surface of the ski. Perhaps, these lines are indicative of some type of boot support above the ski surface.

Of course, because GIGNOUX provides no textual description of engagement of the boot and the ski, any conclusion regarding same amounts to speculation and surmise. Further in this regard, the Manual of Patent Examining Procedure (MPEP), (Rev. 5, Aug. 2005) provides the following guidance regarding arguments such as that advanced in support of the rejection of Applicants' claims based upon what GIGNOUX might have disclosed:

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

MPEP, Section 706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection," provides the following guidance:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicants respectfully submit that, for the reasons given above, a convincing line of reasoning as to why the artisan would have found their invention to have been obvious has not been provided by BEJEAN and GIGNOUX. Accordingly, reconsideration and withdrawal of the rejection is kindly requested.

D. Withdrawal of the Rejection Based Upon BEJEAN+KENNEY

Applicants kindly request reconsideration and withdrawal of the rejection of claim 16 as being unpatentable over BEJEAN in view of KENNEY at least for the following reasons.

Claim 16 includes the subject matter of prior claim 8 and the limitation that at least in part of the central zone of the cross-country ski of the invention, a transverse width of the upper support surface is greater than a width of a lower gliding surface.

BEJEAN discloses a cross-country ski having particular longitudinal guide rib structures by which a longitudinally extending groove in the skier's boot is to become engaged when the sole of the skier's shoe seats flat on the ski.

The invention of KENNEY, on the other hand, "relates to sailing on snow and ice" (see the first paragraph of the specification), which utilizes a sail for propulsion. More particularly, KENNEY discloses a structure of either a monoski, having a head-held of attached sail, or one of a plurality of skis that are to be attached to a platform, i.e., a board or a deck, which includes a sail, in any case, in which "a sailor stands and controls an articulating sailboard sail" (see column 3, lines 16-33).

First, Applicants respectfully submits that the rejection of claim 16 should be withdrawn at least for the reason that the rejection of parent claim 8 should be withdrawn, as explained above.

Second, Applicants submit that one skilled in the art of cross-country skiing would not have adopted what is equivalent to a runner of a land sailing craft, disclosed by KENNEY. Whereas a cross-country ski is structured to facilitate manual propulsion by means of the legs of the skier, whether by means of the classic step or the skating step, KENNEY's sailing craft is not. The latter might find a ski having vertical lift (see column 2, lines 55-56) useful, whereby the cross-sectional shape is triangular, the manual propulsion techniques employed by a cross-country skier, according to those skilled in the art of cross-country skiing, requires different structures.

For example, in the "kick-zone" of a cross-country ski, for those utilizing the classic technique, e.g., a kick wax is used which provides grip on the snow when the skier's weight is transferred to the ski. The apex of the triangular shape of KENNEY's ski/runner, which

minimizes surface contact, as mentioned in the rejection on page 5, line 6, would not provide a skier with a gripping surface.

Likewise, KENNEY's structure would not facilitate a cross-country skier practicing the skating technique, who relies on a decisive weight transfer onto one angled ski and then the other, while being supported and pushing on the inner edge of the ski on the snow. KENNEY's sailor would not be concerned with such mechanics.

In addition, KENNEY's ski/runner has an inverse camber compared to that of a conventional ski. See Figs. 1 and 3, e.g., and column 4, lines 18-20. This shape would not facilitate the mechanics required to propel a cross-country ski, whether during the practice of the classic technique or the skating technique.

At least in view of the foregoing, Applicants submit that a convincing line of reasoning as to why the artisan would have found their invention to have been obvious has not been provided by the combination of BEJEAN and KENNEY. Accordingly, reconsideration and withdrawal of the rejection is kindly requested.

D. New Claims

New dependent claims 27-39 have been added.

All of the new claims are believed to be allowable at least for the reasons given above in connection with the claims from which they depend. They also provide additional reasons for allowance.

Claims 27, 30, and 35, depending from claims 8, 13, and 21, respectively, call for the upper support surface of the ski to extend to an outer transverse edge of the upper surface of the ski, and that the upwardly facing recess of the upper surface of the ski extends to a depth below the upper support surface. This structure is not taught or suggested by BEJEAN, for example.

Claims 28, 31, and 36, depending from claims 8, 13, and 21, respectively, call for the upwardly facing recess of the location for receiving the binding device to extend within the area corresponding to the metatarsophalangeal bending zone of the wearer's foot.

Claims 29, 32, and 37, depending from claims 8, 13, and 21, respectively, specify that the ski has no boot sole-engaging rib. By contrast, both BEJEAN and GIGNOUX do.

Claims 33, 34, 38, and 39, depending from claims 13, 32, 21, and 37, respectively, specify that the binding device comprises a boot sole-engaging rib rearward of the mechanism for engagement with the boot. By contrast, both BEJEAN and GIGNOUX do not.


CONCLUSION

The rejections advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

Payment is being paid herein for extra claims. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone number, fax number, or e-mail address given below.

Respectfully submitted,
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